

REMARKS

After entry of the supplemental preliminary amendment, filed on July 23, 2003, claims 62-106 were pending in this application. In the Office Action of February 17, 2004, the Examiner rejected claims 94 and 95 under 35 U.S.C. § 112, para. 2 as allegedly indefinite. The Examiner rejected claims 84-85, 87 and 90 under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Pat. No. 5,880,769 to Nemirofsky et al. ("Nemirofsky"). The Examiner rejected claims 62-64, 68-69, 72-81 and 83 under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Pat. No. 5,724,106 to Autry et al. ("Autry") in view of Nemirofsky. The Examiner also rejected claims 65, 67, 92-99, and 101-106 under 35 U.S.C. § 103(a) as being obvious, but only in further view of U.S. Pat. No. 5,955,722 to Kurz et al. ("Kurz"). The Examiner indicated that claim 100 was directed to allowable subject matter and would be allowable if rewritten in independent form including all of the limitations of the base claim.

Applicant has amended claim 64, 66, and 96 to correct typographical errors. Applicant has amended claim 92 to clarify the claimed invention and has rewritten claim 100 as an independent claim including the limitations of unamended claim 92. Finally, Applicant has added a new independent claim 107. Support for claim 107 may be found at least in the paragraph beginning with the words "[w]here a bidirectional communication is provided" on page 5, lines 8-11 of page 10, and lines 10 –14 on page 11 of Applicant's application. No new matter has been added. After entry of this amendment, claims 62-107 are pending.

Objection to the specification

The Examiner objected to the format of the specification and required that the specification comply with U.S. regulation 37 C.F.R. 1.77(b). Applicant amends the specification and abstract to convert the format from an international application to comply with U.S. regulation 37 C.F.R. 1.77(b). The Examiner also objected to the inclusion of references to cancelled claims in the specification. Applicant removes reference to claim numbers that have been cancelled to overcome the Examiner's objection. No new matter has been added.

35 U.S.C. § 112, para. 2 rejections

Claims 94 and 95 stand rejected as allegedly indefinite. The Examiner indicated that the phrase "internet computer integrated in the PC card" did not adequately describe the function of this limitation. The limitation "internet computer" is described in the specification at least on page 3, 4th paragraph and in a description of a specific embodiment on page 10, lines 10-20. Thus Applicant respectfully submits that claims 94 and 95 do "particularly point[] out and distinctly claim[] the subject matter which the [A]pplicant regards as his invention." 35 U.S.C. § 112, para. 2.

35 U.S.C. § 102(e) rejections

Claims 84-85, 87, and 90 stand rejected as allegedly anticipated by Nemirofsky. Claim 84, from which claims 85, 87 and 90 depend, recites, *inter alia*, "A wireless remote control device for a communication module comprising . . . encryption means for encrypting control data to be transmitted *to said communication module*." App. Claim 84 (emphasis added). The Examiner relies on col. 4 , lines 20-25 of Nemirofsky as teaching disclosure of encryption means. Office Action, p. 4, lines 2-3. Nemirofsky,

discloses a system wherein non-visual information may be encoded onto a TV broadcast signal by means of a video encoded invisible light ("VEIL") protocol. Col. 4, lines 2-6. The light emitted from the TV display is received by a VEIL receiver in the smart card, as illustrated in Fig. 4 of Nemirofsky. The smart card, in one embodiment is integrated with a VCR remote control, as illustrated in Fig. 6(a) of Nemirofsky. The non-visual data may be encrypted by one or more data encryption methods.

Nemirofsky, Col. 4, lines 19-21. Because the non-visual data, regardless of whether it is encrypted, is transmitted *from the TV display to the smart card in the remote control*, as illustrated in Fig. 4, Nemirofsky does not disclose at least "[a] wireless remote control device for a communication module comprising . . . encryption means for encrypting control data to be transmitted to said communication module." App. Claim 84. Accordingly, Nemirofsky does not disclose each and every element of claim 84 as is required for anticipation under 35 U.S.C. § 102. Applicant respectfully requests that the Examiner withdraw the rejection and allow the claim.

Claims 85, 87, and 90 each depend directly from claim 84, and thus are allowable for at least the same reason as claim 84. Applicant respectfully requests that the Examiner withdraw the rejection and allow these claims as well.

35 U.S.C. § 103(a) rejections

Over *Autry* in view of *Nemirofsky*

Claims 62-64, 68-69, 72-81 and 83 stand rejected as allegedly obvious over *Autry* in view of Nemirofsky. Claim 62 is directed to a multimedia system reciting, *inter alia*, "a wireless remote control device, [a] base station having a plurality of Common Interface (CI) PC (Personal Computer) card connectors with associated hardware and

software functionality; [and] a communication module in the PC card format incorporating a network client computer and a wireless link to said remote control device for direct control of said network client computer by said remote control device.”

Autry discloses “an entertainment system [with] a personal computer as the heart of the system with a large screen . . . monitor and a radio frequency remote control device.” Autry, abstract. The personal computer (118) includes “[a] processor 310[, which] resides on a system board containing an industry standard PCI bus 312, which is coupled to “a VGA converter card 318, sound card 320, and modem 322,” among other things. Col. 6, line 64 – col. 7, line 3. Figure 1 illustrates these cards as standard size computer cards. The remote control device 124, sends RF signals to the personal computer 118 to operate software, etc. Col. 7, lines 20-37.

Nemirowsky discloses an embodiment in which a smart card 10 communicates to a remotely located network via a modem connected to a telephone line by a PCMCIA style mini connector, or via a wireless connection. Nemirowsky, Col. 3, lines 1-11.

The Examiner relies on Autry for disclosure of “a base station (118) . . . [that] has a plurality of personal computer card connectors (See Figure 3, 316-322),” Office Action at page 5, lines 2-5, implicitly acknowledging that Autry does not disclose “Common Interface (CI) PC (Personal Computer) card connectors.” Explicitly acknowledging that Autry does not disclose “a communication module in a PC card format incorporating a network client computer and a wireless link”, *id.* at lines 9-11, the Examiner relies on Nemirowsky for disclosure of “a communication module in a PC card format (See Figure 2) incorporating a network client (Col. 2, Lines 45-50) and a wireless interface (Col. 3, Lines 9-12),” *id.* at lines 11-13. However, the smart card of Nemirowsky

is described as wirelessly connecting to a network, not to a remote control device. The embodiment of Nemirofsky, relied on by the Examiner, 1) does not have a “remote control device for direct control of said network client computer by said remote control device,” and 2) would not work for its intended purpose, as described by Nemirofsky, to communicate with a remote service via a network, if the smart card were wirelessly connected to the remote control device. Accordingly, the Examiner’s assertion that “Nemirofsky is evidence that ordinary workers in the art would appreciate the ability to house a network controller and wireless interface in a PC smart card” is not a suggestion or motivation to combine the references.

The Examiner admits that Autry in view of Nemirofsky does not disclose “a communication module in the PC card format incorporating . . . a wireless link to said remote control device.” Office Action at page 5, lines 21-22. After taking Official Notice that “it is well known in the art to use a wireless transceiver to communicate with a remote control,” Office Action at page 6, lines 2-3, the Examiner alleges that it would be obvious to modify Autry in light of Nemirofsky to use the “pre-existing transceiver instead of implementing an additional one.” However, the Examiner’s assertion still does not provide a suggestion or motivation to modify the combination of Autry and Nemirofsky, because as stated earlier, modifying the smart card of Nemirofsky to wirelessly communicate with a remote control would make it unable to communicate with the remote service via a satellite network, its intended purpose.

Moreover, the Examiner recognizes that neither Autry or Nemirofsky discloses “a base station having a plurality of Common Interface (CI) PC (Personal Computer) card connectors.” The Examiner addresses this point by asserting that it would be obvious to

one skilled in the art “to modify the system of Autry with the PC-card base[d] network and wireless interface of Nemirowsky in order to reduce the footprint of the system through the use of credit-card sized devices.” The Examiner supports this statement with two other assertions of what would be obvious to one skilled in the art: 1) that it is well known that “PC cards can be used as an alternative to full-sized cards for saving space and 2) that one could incorporate a network controller and wireless interface in a PC smart card,” but does not take Official Notice of these assertions, in contrast to the earlier assertion regarding transceivers, seemingly indicating a difference between them.

Applicant respectfully traverse the Examiner’s rejection of claim 62. As acknowledged by the Examiner, neither Autry nor Nemirowsky discloses “a base station having a plurality of Common Interface (CI) PC (Personal Computer) card connectors with associated hardware and software functionality” or “a communication module in the PC format incorporating a network client computer and a wireless link to said remote control device for direct control of said network client computer by said remote control device.” The Examiner does not allege that the suggestion to modify Autry AND Nemirowsky to create a system with the above limitations comes from either of these references, but from common knowledge of one skilled in the art. Reliance on three different modifications, not found or suggested by the applied references is an improper basis for a rejection. As the MPEP in section 2144.04 (E) guides,

Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner’s conclusion should be judiciously applied. Furthermore, . . . any facts so noticed should be of notorious character and serve only to “fill in the gaps” *in an insubstantial manner* which might exist in the

evidentiary showing made by the examiner to support a particular ground for rejection.

The Examiner's extrapolation from common knowledge is substantial, in that otherwise, at least two entire elements (or three limitations) are not disclosed or even suggested by either reference. Only Applicant's disclosure suggests the particular combination, and it is improper hindsight to use an applicant's disclosure in making an obviousness rejection. *Hodosh v. Block Drug Co., Inc.* 786 F.2d 1135, 1143 n.5 (Fed. Cir. 1986) (cited in MPEP § 2141).

Even if the references could be combined, neither Autry nor Nemirofsky discloses "a base station having a plurality of Common Interface (CI) PC (Personal Computer) card connectors." As mentioned in the specification the Common Interface is a digital television standard, i.e., "DVB CI standard." See e.g., page 1, lines 12-23 and page 8, line 27- page 9, line 4. DVB, of course, stands for the Digital Video Broadcasting (DVB) Project. More information may be found at <http://www.pcmcia.org/papers/future.htm#settop>. A prima facie case of obviousness includes a requirement that the combination of references teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (cited in MPEP § 2143.03). Here, where it is clear that both Autry and Nemirofsky lack this limitation, a prima facie case is not established.

For at least the above reasons, Applicant respectfully requests the rejection be withdrawn and claim 62 be allowed. Claims 63-64, 68-69, 72-81 and 83 depend directly or indirectly from claims 62, and were rejected as unpatentable over these same two references. Applicant also traverses these rejections. Applicant submits that these claims are patentable over Autry in view of Nemirofsky for at least the same reasons

that claim 62 is patentable. Accordingly, Applicant respectfully requests that the rejections be withdrawn and the claims 62-64, 68-69, 72-81, and 83 be allowed.

Over *Autry* in view of *Nemirowsky* in further view of *Kurz*

Claims 65, 67, 92-99, and 101-106 stand rejected as allegedly obvious over Autry in view of Nemirowsky in further view of Kurz. Claim 92 is an independent claim reciting, as amended, “[a] communication module in the form of a personal computer (PC) card comprising an interface and integrated with: a chip card reader; a wireless transmitter/receiver unit; and a conditional access (CA) system, wherein the communication module is insertable into a corresponding slot in a set top box.”

Autry discloses a system which includes a personal computer (118) having a PCI bus and an RF receiver and coupled to a digital receiver card 316. “Digital receiver card 316 contains the coaxial cable connector to the coaxial cable 116 and a [standard PCMCIA] slot [720] for the conditional access card 418.” Col. 10, lines 31-35.

Nemirowsky, as previously discussed, discloses a smart card for remote use from a television set for decoding VEIL encoded non-visual information received from the light emitted by TV display and for communicating to a network via a PCMCIA style mini-connector and telephone cord, or via a wireless interface and a separate embodiment of a smart card inserted into a reader used with a method of increasing security by “requir[ing] the user to enter a PIN code, using the buttons 30 or 32 on the smart card 10, which will be authorized prior to carrying out the transaction.” Col. 6, lines; see col. 5, lines 48-51. Kurz teaches a smart card reader in the format of a PC card, for interfacing with “a personal computer 22 having a receptacle in the form of a standard PCMCIA slot 24,” col. 5, lines 57-60, and notes uses of related art smart card readers

“coupled to digital television controllers, for controlled access to various digital television programs and services,” col. 1, lines 25-29.

The Examiner rejected claim 92 by referencing his rejections of claims 62, 64, 65, and 69, without more. None of the three references disclose “a communication module [in the form of a personal computer (PC) card, which] is insertable into a corresponding slot in a set top box.” Nor is there a suggestion or motivation to combine or modify the references in any of the references to teach “a communication module [in the form of a personal computer (PC) card, which] is insertable into a corresponding slot in a set top box.” To begin with there is no suggestion or motivation in Autry to add a wireless transceiver unit to the digital satellite system (DSS) card and to modify the receiver card 316 to be in the format of a PC card. There is no suggestion or motivation in Nemirowsky that the smart card “is insertable into a corresponding slot in a set top box,” nor does Nemirowsky disclose or suggest any use of the smart card in that way. In fact, to modify the smart card of Nemirowsky in that fashion would defeat its purpose of being remote from the television set. There is no suggestion or motivation in Kurz to provide any additional components to the smart card reader, nor any suggestion that set top boxes would interface with the smart card reader in the PC card form such that it would be “insertable into a corresponding slot in a set top box.” Just as Applicant traversed the Examiner’s assertion in rejecting claim 62 that one skilled in the art would supply the motivation to combine and modify the references to provide the subject matter of that claim, Applicant does so here as well. In summary, Applicant respectfully submits that a prima facie case of obviousness has not been established for claim 92 as

amended. Applicant respectfully requests that the Examiner allow the claim as amended.

Claims 65 and 69 each indirectly depend from claim 62. Applicant has already traversed the rejection of claim 62 over Autry in view of Nemirofsky. As discussed previously, Kurz does not remedy the deficiency of Autry and Nemirofsky. Accordingly, claims 65 and 69 are patentable over Autry in view of Nemirofsky in further view of Kurz.

New claim 107

New claim 107 recites, *inter alia*, “both the communication module and the remote control device comprise a transmitting/receiving unit for a wireless bi-directional communication between the remote control device and the communication module,” at least which Autry, Nemirofsky, and Kurz do not disclose or suggest. Therefore, Applicant respectfully requests the Examiner to allow this claim.

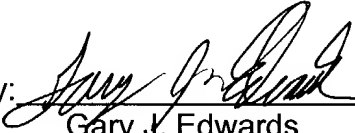
In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 19, 2004

By: 
Gary J. Edwards
Reg. No. 41,008

**Express Mail Label No.
EV 533069971 US**